



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/552,313

09/11/2006

Tobias Schweiger

298-303

8267

7590
Dilworth & Barrese
333 Earle Ovington Blvd.
Suite 702
Uniondale, NY 11553

03/03/2010

EXAMINER

DONADO, FRANK E

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

03/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,313	Applicant(s) SCHWEIGER ET AL.	
	Examiner FRANK DONADO	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-26, 28, 30, 33, 34 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-26, 28, 30, 33, 34 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 11/30/09 has been entered. Claims 1, 22, and 37 have been amended. Claims 21, 27, 29, 31, 32, 35, and 36 have been cancelled. No claims have been added. Claims 1-20, 22-26, 28, 30, 33-34 and 37 are currently pending in this application, with claims 1, 33 and 37 being independent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 2617

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-17, 19, 20, 22-25, 28, 30, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant, et al (**US Patent No. 5,802,468**), in view of Harvinis, et al (**US PG Publication 6,216,007**). From now on, Gallant, et al, will be referred to as Gallant, and Harvinis, et al, will be referred to as Harvinis.

Regarding claim 1, Gallant teaches a communications system for mobile radio telephony, the system comprising: a plurality of mobile devices operable within a total territory of the communication system (**Calling areas are defined within a mobile communication system, where said communication system include a plurality of mobile stations operable within said communication system, Column 1, lines 7-10 and 67**), the total territory being divided into a plurality of location areas (**Said communication system is divided into a plurality of cells that define the current location of said mobile stations, Column 2, lines 32-39**), each mobile device comprising a module insertable into, removable from and distinct from the mobile device (**A Subscriber Identification Module (SIM) is inserted into said mobile station, Column 7, lines 32-37**), each mobile device being associated with at least one subscriber territory being fixed inside the total territory (**An identification code in said SIM defines the home geographic location for said mobile station used to define a**

Art Unit: 2617

home calling area, Column 7, lines 32-46), wherein the at least one subscriber territory includes at least a portion of at least one location area from among the plurality of location areas and wherein a processor coupled to the module is configured to determine whether a respective mobile device is located inside the at least one subscriber territory **(Said home calling area overlaps said cells, and said mobile station uses SIM information to determine its location with respect to its home calling area, Column 7, lines 54-55 and Column 10, lines 19-31)**. Gallant does not teach the location determination is performed by an application within the SIM. Harvinis teaches the location determination is performed by an application within the SIM **(A location calculation module (LCM) resides within a smart IC card that is a SIM card for determining the location of a mobile terminal, Column 3, lines 9-26)**. Since the module of Harvinis stores BTS identifiers and performs a location calculation, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to include this feature for the benefit of transmission efficiency and service variety.

Regarding claim 2, Gallant, in view of Harvinis, teaches a communications system in accordance with claim 1. Harvinis further teaches the module is the subscriber identification module **(Column 3, lines 9-26 and Column 5, lines 21-24)**.

Regarding claim 3, Gallant, in view of Harvinis, teaches a communications system in accordance with claim 1. Gallant further teaches location areas in which one

Art Unit: 2617

or more radio cells are located are arranged in the total territory covered by the communications system **(Said home calling areas that overlap with cells lie within said communication system, Column 7, lines 42-46).**

Regarding claim 4, Gallant, in view of Harvinis, teaches a communications system in accordance with claim 3. Gallant further teaches location areas and/or the radio cells have identity data characterizing them **(Said home calling areas are associated with assigned BTS identifiers, Column 10, lines 11-19).**

Regarding claim 5, Gallant, in view of Harvinis teaches a communications system in accordance with claim 4. Gallant further teaches the identity data include identifiers and coordinates **(Said home calling areas are associated with assigned BTS identifiers and their corresponding coordinates, Column 10, lines 11-19).**

Regarding claim 6, Gallant, in view of Harvinis teaches a communications system in accordance with claim 4. Gallant further teaches the system comprising means for transmitting the identity data of the location areas and/or of the radio cells to the mobile devices **(Said mobile station receives and decodes coordinate identifier fields transmitted by a Base Transceiver Station (BTS) that control said cells, Column 10, lines 19-21 and Column 7, lines 54-55).**

Regarding claim 7, Gallant, in view of Harvinis teaches a communications system

Art Unit: 2617

in accordance with claim 1. Gallant further teaches an interface is provided in the mobile devices by means of which the identity data can be transmitted to the module **(Cell identifier information is transmitted to the mobile unit, Column 10, lines 19-21 and Column 7, lines 54-55).**

Regarding claim 8, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Gallant further teaches means are provided in said processor coupled to the module by means of which the identity data of the location area or radio cell in which the mobile device is located can be compared with data characterizing the subscriber territory **(Said assigned BTS identifiers defining coordinates of the home calling area are compared with BTS identifiers of said mobile station's current location during a registration process of said mobile station, Column 10, lines 19-31).** Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24).**

Regarding claim 9, Gallant, in view of Harvinis teaches a communications system in accordance with claim 8. Gallant further teaches the data characterizing the subscriber territory include identifiers and coordinates of the locations areas and/or radio cells located in the subscriber territory **(Said assigned BTS identifiers define**

coordinates of the home calling area, Column 10, lines 19-31).

Regarding claim 10, Gallant, in view of Harvinis teaches a communications system in accordance with claim 8. Gallant further teaches the data characterizing the subscriber territory are stored in the module **(Said identification code that defines home calling area information is stored in said SIM, Column 7, lines 32-46).**

Regarding claim 11, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Harvinis further teaches the module is effective to determine whether the coordinates of a location area or of a radio cell of the communications system are disposed in a region which is fixed by a location **(Coordinates of said mobile subscriber are determined by said SIM to define said location, Column 4, lines 62-67 and Column 5, lines 1-4).** Gallant further teaches the radius of a circle surrounding the location as a center **(Said home calling area is defined by a circular area with a radius, where said home calling area and its associated coordinates are used to determine whether mobile device is located inside home location, Column 7, lines 46-49, Column 10, lines 16-18 and Column 10, lines 25-28).**

Regarding claim 12, Gallant, in view of Harvinis teaches a communications system in accordance with claim 11. Gallant further teaches the coordinates of the location and the radius are stored in the module **(Said coordinates of said**

Art Unit: 2617

geographical address of said mobile station used to define said radius are stored in said SIM, Column 10, lines 16-18 and Column 7, lines 42-49).

Regarding claim 13, Gallant, in view of Harvinis teaches a communications system in accordance with claim 11. Gallant further teaches the identifiers of the location areas and/or of the radio cells identify the corresponding coordinates of the location area and/or of the radio cell to which they apply to facilitate a determination of the coordinates from the identifiers **(Both said cell identifiers and said identification codes that define home calling areas have corresponding coordinates, Column 10, lines 12-17 and Column 3, lines 23-26).**

Regarding claim 14, Gallant, in view of Harvinis teaches a communication system in accordance with claim 13. Gallant further teaches the identifiers of the location areas and/or of the radio cells are designated such that they are in a relationship with the coordinates of the location area and/or of the radio cell so that the coordinates can be determined from the identifiers **(Both said cell identifiers and said identification codes that define home calling areas have corresponding coordinates and, as is commonly understood in the art, are uniquely different from one another, Column 10, lines 12-17 and Column 3, lines 23-26).**

Regarding claim 15, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Harvinis further teaches means are provided in the

Art Unit: 2617

module by which the coordinates can be determined **(Said SIM LCM application determines said coordinates of mobile terminal, Column 4, lines 62-67 and Column 5, lines 1-4)**. Gallant further teaches coordinates are determined on the basis of the identifiers **(Coordinates are associated with said identifiers of home calling areas, Column 3, lines 23-26)**.

Regarding claim 16, Gallant, in view of Harvinis teaches a communications system in accordance with claim 15. Gallant further teaches a processor coupled to the module has means by which it can be determined whether the identifier of a location area and/or of a radio cell coincides with a predetermined identifier of the location area and/or of the radio cell of the subscriber territory **(Said home calling area identification is predetermined and current cell area information is then determined from current cell ID information and compared within said processor coupled to SIM module, Column 7, lines 32-37 and Column 10, lines 19-31)**.

Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24)**.

Regarding claim 17, Gallant, in view of Harvinis teaches a communications system in accordance with claim 16. Gallant further teaches the predetermined

Art Unit: 2617

identifier is stored in the module **(Said identification code that defines home calling area information is stored in said SIM, Column 7, lines 32-46).**

Regarding claim 19, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Gallant further teaches the system further comprises an interface between the mobile device and the module to facilitate the transmission of a control signal indicating whether the mobile device is located in a subscriber territory **(The mobile unit communicates with said BTS and the determination is made as to whether the mobile unit location is within its home calling area, Column 10, lines 19-31).**

Regarding claim 20, Gallant, in view of Harvinis teaches a communication system in accordance with claim 1. Gallant further teaches the system configured to perform a method of operating a communications system for mobile radio telephony **(Calling areas are defined within a mobile communication system, where said communication system include a plurality of mobile stations operable within said communication system, Column 1, lines 7-10 and 67),** the communication system being divided into a plurality of location areas **(Said communication system is divided into a plurality of local calling areas that are larger than home calling areas, Column 7, lines 22-24),** each location area including at least one radio cell **(Said communication system is divided into a plurality of cells that overlap with said home calling areas that are contained within said local calling areas, indicating**

Art Unit: 2617

local calling areas contain cells, Column 7, lines 54-55 and 60-63), the method comprising: assigning at least one subscriber territory to a mobile device, the subscriber territory being defined according to three parameters, a subscriber X-coordinate position, a subscriber Y-coordinate position and a subscriber radius R, the three parameters collectively defining a circular subscriber territory within a total territory of the communication system **(Said home geographic location that is used to define said home calling area and is defined by said identification code in said SIM includes coordinate and radius information, Column 7, lines 32-49 and Column 10, lines 16-18)**; receiving an X-coordinate position and a Y-coordinate position of one of said location areas or radio cells within the communication system at the mobile device **(Said mobile station receives and decodes coordinate identifier fields transmitted by a Base Transceiver Station (BTS) that control said cells, Column 10, lines 19-21 and Column 7, lines 54-55)**; determining whether the received X-coordinate position and the received Y-coordinate position of one of said location areas or radio cells is disposed within the subscriber territory as defined by said subscriber X-coordinate position, said subscriber Y-coordinate position and subscriber radius R **(Said home calling area overlaps said cells, and said mobile station uses SIM information to determine its location with respect to its home calling area, Column 7, lines 54-55 and Column 10, lines 19-31)**; and informing a subscriber of the mobile device that the subscriber is within the subscriber territory in the case where said determining step is true **(Result from said determination is sent accordingly, Column 10, lines 31-33).**

Art Unit: 2617

Regarding claim 22, Gallant, in view of Harvinis teaches a communication system in accordance with claim 20. Gallant further teaches the examination whether the coordinates of a location area and/or of a radio cell are disposed in a region which is fixed by a location and the radius of a circle surrounding the location as a center is performed by said processor coupled to the module **(Said determination occurs at SIM, Column 10, lines 19-31)**. Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24)**.

Regarding claim 23, Gallant, in view of Harvinis teaches a communication system in accordance with claim 1. Gallant further teaches an examination whether the identifier of a location area or of a radio cell coincides with a predetermined identifier of a location area or of a radio cell is performed by said processor coupled to the module **(Comparisons of said cell identifiers and said identifiers of home calling areas take place at the SIM, Column 10, lines 19-31)**. Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24)**.

Art Unit: 2617

Regarding claim 24, Gallant, in view of Harvinis teaches a communication system in accordance with claim 22. Gallant further teaches said examination whether the identifier of a location area or radio cell coincides with a predetermined identifier takes place prior to the examination whether the coordinates of a location area and/or of a radio cell are disposed in a region which is fixed by a location and the radius of a circle surrounding the location as a center is performed by said processor coupled to the module **(The identifiers are decoded before a radius distance values is calculated, Column 10, lines 19-28)**. Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24)**.

Regarding claim 25, Gallant, in view of Harvinis teaches a communication system in accordance with claim 20. Gallant further teaches the location and the radius of the region and/or the predetermined identifiers are stored in the module **(Said predetermined identifiers of home calling areas are stored in said SIM, Column 7, lines 32-37 and 42-46)**.

Regarding claim 28, Gallant, in view of Harvinis teaches a communication system in accordance with claim 20. Gallant further teaches the identifier of the location area and/or of the radio cell and/or their coordinates are forwarded by a

Art Unit: 2617

transmitter and receiver station to the module within the mobile device. **(Said BTS transmits coordinate information to said SIM, Column 10, lines 19-21).**

Regarding claim 30, Gallant, in view of Harvinis teaches the communication system according to claim 20. Gallant further teaches the assigning step further comprises storing the three parameters within a memory of the mobile device **(Said coordinates are stored in said SIM, Column 10, lines 16-18).**

Regarding claim 33, Gallant teaches a method of operating a communications system for mobile radio telephony, the communication system being divided into a plurality of location areas **(A communication system is divided into a plurality of local calling areas that are larger than home calling areas, Column 7, lines 22-24),** each location area including at least one radio cell **(Said communication system is divided into a plurality of cells that overlap with said home calling areas that are contained within said local calling areas, indicating local calling areas contain cells, Column 7, lines 54-55 and 60-63),** the method comprising: assigning at least one first identifier to a mobile device defining at least one subscriber territory of the mobile device **(Said home calling areas are associated with assigned BTS identifiers, Column 10, lines 11-19);** receiving, at the mobile device, a second identifier of one of a location area or a radio cell within the communication system **(Current areas in which said mobile station is located are associated with BTS identifiers of said mobile station's current location, Column 10, lines 19-31);**

Art Unit: 2617

determining, using a processor coupled to the module insertable into, removable from, and distinct from the mobile device, whether the first identifier matches the second identifier (**Comparisons of said cell identifiers and said identifiers of home calling areas take place, Column 10, lines 19-31**); and informing a subscriber of the mobile device that the subscriber is within the subscriber territory when the first identifier matches the second identifier (**Result from said determination is sent accordingly, Column 10, lines 31-33**). Gallant does not teach the location determination is performed by an application within the SIM. Harvinis teaches teach the location determination is performed by an application within the SIM (**A location calculation module (LCM) resides within a smart IC card that is a SIM card for determining the location of a mobile terminal, Column 3, lines 9-26**). Since the module of Harvinis stores BTS identifiers and performs a location calculation, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to include this feature for the benefit of transmission efficiency and service variety.

Regarding claim 34, Gallant, in view of Harvinis teaches the method according to claim 33. Gallant further teaches the assigning step further comprises storing the predetermined identifier within the module of the mobile device (**Said predetermined identifiers of home calling areas are stored in said SIM, Column 7, lines 32-37 and 42-46**).

Art Unit: 2617

6. Claims 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant, in view of Harvinis, and further in view of Olds (**US Patent No. 5,905,957**).

Regarding claim 18, Gallant, in view of Harvinis, teaches a communications system in accordance with claim 1. Gallant, in view of Harvinis, does not teach the identifiers stored in the module are at least partly stored in a form reducing the storage requirements. Olds teaches the identifiers stored in the module are at least partly stored in a form reducing the storage requirements (**The manner in which the service area information is stored in the SIM helps reduce the amount of faulty registrations, Column 9, lines 41-44 and 48-55**). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant, in view of Harvinis to include this feature in the Subscriber Identity Module for the benefit of cost savings.

Regarding claim 26, Gallant, in view of Harvinis, teaches a method in accordance with claim 25. Gallant, in view of Harvinis does not teach the predetermined identifiers are at least partly stored in a manner reducing the memory requirements in the module. Olds teaches the predetermined identifiers are at least partly stored in a manner reducing the memory requirements in the module (**The manner in which the service area information is stored in the SIM helps reduce the amount of faulty registrations, Column 9, lines 41-44 and 48-55**). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant,

Art Unit: 2617

in view of Harvinis to include this feature in the Subscriber Identity Module for the benefit of cost savings.

7. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant in view of De Beer **(US PG Publication 2005/0101323)**.

Regarding claim 37, Gallant teaches a communications system for mobile radio telephony the system comprising: a plurality of mobile devices operable within a total territory of the communication system **(Calling areas are defined within a mobile communication system, where said communication system include a plurality of mobile stations operable within said communication system, Column 1, lines 7-10 and 67)**, the total territory being divided into a plurality of location areas **(Said communication system is divided into a plurality of cells that define the current location of said mobile stations, Column 2, lines 32-39)**, each mobile device comprising a module insertable into, removable from and distinct from the mobile device **(A Subscriber Identification Module (SIM) is inserted into said mobile station, Column 7, lines 32-37)**, each mobile device being associated with at least one subscriber territory being fixed inside the total territory **(An identification code in said SIM defines the home geographic location for said mobile station used to define a home calling area, Column 7, lines 32-46)** wherein the at least one subscriber territory includes at least a portion of at least one location area from among the plurality of location areas **(Said home calling area overlaps said cells, and said mobile station**

Art Unit: 2617

uses SIM information to determine its location with respect to its home calling area, Column 7, lines 54-55 and Column 10, lines 19-31). Gallant does not teach each module is configured to poll a determination unit external from the mobile device to determine whether a respective mobile device is located inside the at least one subscriber territory. De Beer teaches each module is configured to poll a determination unit external from the mobile device and receive information from the determination unit regarding whether a respective mobile device is located inside the at least one subscriber territory **(A SIM contained in a mobile station stores and maintains a routing table 13 comprising location information used during registrations with a network, where said routing table 13 is updated with information received from a control centre external to said mobile station when said control centre determines said mobile station is outside of a subscriber territory, Paragraphs 33, Paragraph 37, lines 3-6, Paragraph 38, lines 1-11 and Paragraphs 66-67).** It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to include this feature for the benefit of good customer service.

Response to Arguments

8. Applicant's arguments regarding claims 1-20, 22-26, 28, 30 and 33-34, filed 11/30/09, have been fully considered but they are not persuasive for the following reasons:

Regarding Harvinis not disclosing a module that can determine whether a respective mobile device is located inside a subscriber territory as is claimed, the LCM

Art Unit: 2617

of Harvinis is contained on a SIM, where the LCM calculates the mobile terminal location, as indicated in Column 3, lines 18, 19, and 24-26. The BTS coordinates are used by said SIM/LCM application to determine said location of mobile terminal, as indicated in Column 3, lines 9-26, Column 4, lines 62-67 and Column 5, lines 1-4. Finally the location of the mobile terminal pertains to a location of the mobile terminal within a cellular network, as indicated in Column 1, lines 8-10. Since the location of the mobile terminal may be determined specific or relative to a cellular network and BTS coordinates identify subscriber location (for example for billing purposes while roaming, etc), the SIM of Harvinis may be used to determine whether the mobile device is located inside a subscriber territory.

Regarding the combination of Gallant and Harvinis not teaching a SIM card performing calculations based on an identifier as claimed in independent claim 33, the SIM card of Harvinis uses BTS information to calculate a location, as indicated in Column 3, lines 9-26, Column 4, lines 62-67 and Column 5, lines 1-4. The BTS information of Gallant includes BTS identification information that is used to determine a location, where said calculation is made by a processor (33 of Figure 2) within the mobile station, as indicated in Column 10, lines 11-31. Since the SIM card of Harvinis performs location calculations using BTS information, and BTS identifier information is used to perform location calculations within a mobile station, it follows the combination of Gallant and Harvinis teaches a SIM card performing calculations based on an identifier as claimed in independent claim 33.

Regarding transmission efficiency being unrelated to the change and therefore not a motivation for combining the references of Gallant and Harvinis, a greater transmission efficiency is achieved when less processing is executed in communications systems. Since using only the SIM card of Harvinis in the mobile station of Gallant instead of both the processor and the SIM card to calculate a location would involve less processing, as explained in the rejection, less processing is achieved by this combination and therefore a greater transmission efficiency.

Regarding the modification of Gallant to include the SIM card feature of Harvinis not being simply a rearrangement of parts because a more complex and expensive SIM card is used, the inclusion of the features of the SIM card of Harvinis in the mobile station is not a rearrangement of parts. However, this argument is considered moot, because one of ordinary skill in the art would readily recognize the combination of the SIM card of Harvinis with the mobile station of Gallant, as stated in the rejection.

9. Applicant's arguments with respect to claim 37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK DONADO whose telephone number is (571) 270-5361. The examiner can normally be reached Monday-Friday, 9:30 am-6 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6361.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Art Unit: 2617

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-273-8300.

/Frank Donado/

Art Unit 2617

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617